



DECEMBER

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PATENT APPLICATION
Attorney Docket No. DS/91068

GP- 2911

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): James B. Williams et al.

Application No 07/715,258

Filed: June 14, 1991

Examiner: M. Tung

Art Unit: 2911

Title: **ICON FOR COMPUTER DISPLAY**

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope to: Assistant Commissioner for Patents, Washington, D. C. 20231, on

12/3/98

(Date of transmission)

Elaine Zahn

Assistant Commissioner for Patents
Washington, D.C. 20231

Elaine Zahn
(Signature)

Sir:

12/3/98
Date of Signature

PETITION TO SUSPEND PROSECUTION UNDER 37 CFR 1.103

For the reasons set forth below, petitioner hereby petitions, under 37 CFR 1.103, to suspend prosecution of the above-mentioned design patent application for the time interval requested below. The present design patent application is part of one of the following five cases:

07/342,516
07/343,181
07/715,263
07/715,840
07/715,258

Petitioner is currently in the process of appealing the following nine design patent applications to the Court of Appeals for the Federal Circuit ("CAFC"):

07/342,517
07/343,182
07/715,262
07/715,261
07/715,145
07/715,144
07/715,260
07/715,257
07/715,259

The status of all of the above-mentioned fourteen (14) design patent applications are summarized in the following table.

SERIAL NUMBER	STILL BEFORE EXAMINER	NOTICE OF APPEAL FILED WITH CAFC
07/342,516	X	
07/343,181	X	
07/342,517		X
07/343,182		X
07/715,263	X	
07/715,262		X
07/715,261		X
07/715,145		X
07/715,144		X
07/715,840	X	
07/715,260		X
07/715,257		X
07/715,258	X	
07/715,259		X

All of the cases in the above table are related in that petitioner(s), for each case, seeks to amend the drawing on the basis of similar disclosure in each of the originally filed applications. Each case stands rejected on the basis that such amendment impermissibly introduces new matter. It is submitted that resolution of any one of the nine cases before the CAFC will be immediately determinative of the issue in each of the five cases before the USPTO.

Clearly, nothing is to be gained by further prosecution of the present case until a determinative resolution of the new matter issue can be obtained from the CAFC. Moreover, an adverse ruling on the new matter issue at the CAFC would result in an abandonment of the present case.

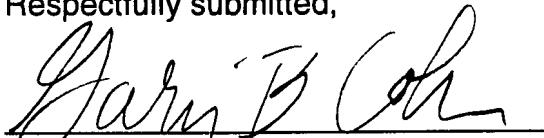
Finally, continued prosecution of the present case would result in undue hardship for the Petitioner since there is no assurance that Petitioner would be able to consolidate the present case with the nine cases before the CAFC. Consideration of the present case separately from the nine cases before the CAFC would result in piece-meal consideration of the present case with respect to the nine cases.

By contrast, suspension of prosecution of the present case would not result in hardship for the USPTO, and may even present a benefit to the USPTO since further consideration of the present case by the USPTO may very well be obviated by a CAFC decision for any one the nine cases before the CAFC.

In balance, suspension of prosecution of the present case until a determinative resolution of the new matter issue can be obtained for any one of the nine cases before the CAFC would avoid piece-meal consideration of the present case relative to the nine cases before the CAFC, and would not result in any hardship or inconvenience for the USPTO. Moreover, suspension of prosecution of the present case would represent an efficient use of USPTO resources. Accordingly, suspension of prosecution of the present case pending a decision for any one of the nine cases before the CAFC is respectfully requested.

Please charge any fees for the above Petition to Xerox Corporation Deposit Account No. 24-0025.

Respectfully submitted,



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GBC/ez

December 3, 1998

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